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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/938,870

08/23/2001

Tony F. Rodriguez

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11/21/2006

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

BROWN, CHRISTOPHER J

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/938,870	Applicant(s) RODRIGUEZ ET AL.	
	Examiner Christopher J. Brown	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 17 is/are allowed.
- 6) ☒ Claim(s) 12 and 16 is/are rejected.
- 7) ☒ Claim(s) 13-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, filed 9/20/2006, with respect to USC 102 (b) have been fully considered and are persuasive. The rejection of claim 12 has been withdrawn.

The applicant argues that the 102(b)rejection of claims 12,13, and 16 by GB 2346110 Furley does not teach using the relationship between the first and second digital watermarks to determine authenticity of the printed object. The argument is persuasive and the examiner withdraws the Furley rejection.

The applicant argues that the amendment to claim 12 overcomes the previous USC 112 rejection. The examiner agrees the amendments to claim 12 overcome the USC 112 rejection. This rejection is withdrawn.

The applicant is correct in that claims 13-15 cannot be rejected via a USC 103 rejection in view of Rhoads. These rejections are withdrawn.

Applicant's arguments filed 9/20/2006 have been fully considered but they are not persuasive. Applicant argues that the amendment to claim 12 has overcome the rejection by US 6,332,031 Rhoads. The amendment to claim 12 does not differentiate claim 12 from the prior art in any way. The applicant has amended the claim to state "the substrate

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having a varying structure that causes optical variations that convey the first digital watermark in the image data captured from the substrate". The examiner asserts that all substrates have a varying structure to cause optical variations. For example, ink causes a varying structure. The amendment does not overcome the art of record.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by

Rhoads US 6,332,031

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Claims 12 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads US 6,332,031.

As per claims 12, and 16 Rhoads teaches a method of detecting a first watermark from a substrate of the printed object, (Col 2 lines 47-55) Rhoads teaches detecting a second digital watermark from an image scanned from the printed object and using the relationship between the first and second objects to determine authenticity of the printed object, (Col 2 lines 55-65, Col 3 lines 45-65).

Allowable Subject Matter

4. The following is a statement of reasons for the indication of allowable subject matter:

As per claims 1 and 6, Wang US 6,263,086 (Wang 086) teaches embedding an invisible watermark in a halftone screen structure. (Col 1 lines 49-53, Col 2 lines 1-5). Wang does not teach errors when the screen is reproduced.

Adler teaches use of measuring the Strength of a fragile watermark for which any tampering of the image is detected through errors produced in the watermark (Col 2 lines 30-35).

However, neither Wang or Adler teach using an inherently unstable screen structure to detect reproduction errors.

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As per claim 6, Adler teaches using the errors of the fragile watermark to detect reproduction, (Col 2 lines 30-35). Adler teaches printing digital files, see Figs 8-11. However, neither Wang or Adler teach using an inherently unstable screed structure to detect reproduction errors.

Wang US 6,252,971 (Wang 971) teaches that reproduction of halftone structures produces distortion and non-uniformity, (Col 1 line 57- Col 2 line 10).

However Wang 971 teaches away from the instant application because it is attempting to solve the problem of distortion production and non-uniformity.

As per claim 17, Wang-Adler-Wang teaches printed watermarks but fails to teach a fiducial. Rhodes teaches use of fiducial marks to find a watermark (Col 57 line 57 – Col 58 line 2).

However Rhodes fails to teach using the fiducial in a comparative way to determine the authenticity of the watermark.

Claims 1-11, and 17 are allowed over the current art of record. Claims 13-15 are objected to due to their dependence on independent rejected claims.

Conclusion

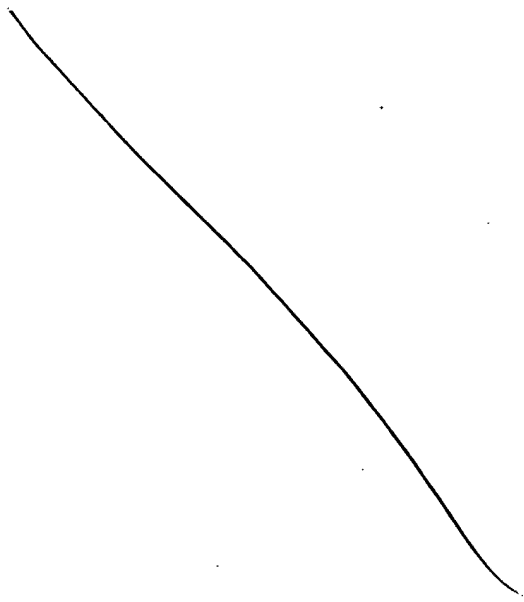
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Brown whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571)272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher J. Brown

11/15/06

CJB


GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100